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Dated: April 11, 2005

Signature

(Beth J. Cobb)

Docket No.: HO-P01426US2
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Patent Application of:
William T. Carpenter

Application No.: 09/773,815

Group Art Unit: 3673

Filed: January 31, 2001

Examiner: J. J. Kreck

For: METHOD OF MODIFYING THE AXIS OF
ROTATION OF THE EARTH

TRANSMITTAL LETTER

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed are the following items for filing in connection with the above-referenced Patent Application:

1. Original and two copies of Appellant's Brief (37 C.F.R. 1.192);
2. Return Receipt Postcard.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 06-2375, under Order No. HO-P01426US2. A duplicate copy of this paper is enclosed.

Dated: April 11, 2005

Respectfully submitted,

By

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ATTORNEY DOCKET NO. P01426US2

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor(s): William T. Carpenter

Serial No.: 09/773,815

Examiner: Kreck, John J.

Filing Date: January 31, 2001

Group Art Unit: 3673

Title: Method of Modifying the Axis of Rotation of the Earth

MS Appeal Brief - Patents
Commissioner for Patents
Alexandria VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on November 4, 2004.

The fees required under § 1.17(c) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. 1.192(c)):

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
 - A. Rejections under 35 U.S.C. § 112, first paragraph
 - B. Rejections under 35 U.S.C. § 103(a)
 - C. Conclusion

VIII. Claims Appendix

IX. Evidence Appendix

X. Related Proceedings Appendix

The final page of this brief bears the attorney's signature.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is William T. Carpenter, a U.S. citizen and resident of Houston, Texas.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There is a total of 10 claims in the application, which are identified as claims 11-20.

B. Status of All the Claims

1. Claims canceled: Claims 1-10.
2. Claims withdrawn from consideration but not canceled: NONE.
3. Claims pending: Claims 11-20.
4. Claims allowed: NONE.
5. Claims rejected: Claims 11-20.

C. Claims on Appeal

The claims on appeal are: Claims 11-20.

IV. STATUS OF AMENDMENTS

Appellant did not file a Response to the Final Rejection dated May 4, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 11 is the only independent claim pending in the application. It relates to a method of modifying the earth-rotation vector in relation to the body of the planet or in inertial space by redistributing the mass in/or/on the crust of the earth. 4:11-13; 7:1-11. Such redistribution will

change the center of mass of the Earth thereby causing a change in the earth-rotation vector. 4:13-14.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review on appeal:

1. Claims 11-20 have been rejected as unpatentable under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.
2. Claims 11-20 have been rejected under 35 U.S.C. § 103 as obvious and unpatentable over Chao, B.F., Anthropogenic impact on global geodynamics due to water impoundment in major reserves, Geophys. Res. Lett., 22, 3529-3532, 1995 (hereinafter, "Chao") in view of JOHN WHITE, POLE SHIFT: PREDICTIONS AND PROPHECIES OF THE ULTIMATE DISASTER 80-81, 180-81 (Doubleday & Co., Inc. 1980) ("White") and Hugh Auchincloss Brown, Cataclysms of the Earth 151-56 (Twayne Publishers, Inc. 1996) ("Brown").

VII. ARGUMENT

Claims 11-20 are currently pending. The Examiner has rejected all pending claims under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement and under 35 U.S.C. § 103 as unpatentable over Chao in view of White and Brown.

A. Enablement

The Examiner failed to make a *prima facie* case of lack of enablement by failing to construe the rejected claims and failing to provide a sufficiently reasoned basis for rejecting the claims. The Examiner rejected claims 11-20 on the grounds that the specification "fails to disclose any equations or methods to perform" the calculating step in claim 11. Without referring to any particular claim, the Examiner also rejected claims 11-20 on the grounds that Applicant's disclosure "fails to disclose how the liquid would be captured and placed in predetermined locations," "fails to disclose how much mass would be required to make an appreciable change in the axis of rotation," and that those failures "would require undue experimentation for one skilled in the art to carry out the claimed invention."

"Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims." MPEP § 2164.04. The Examiner construed only one term, "calculating," in the pending claims. However, the Examiner contended that Applicant's disclosure also "fails

to disclose how the liquid would be captured and placed in predetermined locations,” “fails to disclose how much mass would be required to make an appreciable change in the axis of rotation,” and that those failures “would require undue experimentation for one skilled in the art to carry out the claimed invention.” The Examiner failed to construe all claim terms related to those grounds for rejection, including but not limited to terms related to the determining and positioning steps.

The Examiner also failed to rebut adequately the presumption that Applicant’s disclosure is accurate. *C.f., In re Bowen*, 492 F.2d 859, 862-63 (C.C.P.A. 1974). When the Examiner rejects a claim for lack of enablement, “it is incumbent upon the Patent Office . . . *to explain why it doubts the truth or accuracy of any statement* in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.” *Id.* (emphasis added).

As Applicant discussed in its response to the non-final action mailed August 27, 2003, Applicant’s disclosure states that “[t]he invention may be readily understood by one of ordinary skill in the art without the benefit of a drawing.” (p. 4; lns. 17-18). Applicant’s disclosure also explains how a desired result from employing the present invention “can be reasonably determined by one of ordinary skill in the art” reviewing the disclosure. (p.4; lns. 20-28). The Examiner supported his conclusion that Applicant’s disclosure “would require undue experimentation for one skilled in the art to carry out the claimed invention” only with the statements that Applicant’s disclosure “fails to disclose how the liquid would be captured and placed in predetermined locations,” “fails to disclose how much mass would be required to make an appreciable change in the axis of rotation.” The Examiner failed to provide any evidence or explanation to demonstrate why Applicant’s disclosure must provide that information before one of ordinary skill may practice the present invention without undue experimentation. The Examiner failed to provide the required explanation or otherwise present sufficient reasoning to rebut the presumption. Rather, the Examiner made only the bare statement that “Examiner has provided sufficient reasoning to the contrary; thus a prima facie case has been made.”

The Examiner also failed to support his conclusion that Applicant’s disclosure does not enable one of ordinary skill to practice the present invention without undue experimentation. “Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.” *In re Wands*, 858 F.2d

731, 737 (Fed. Cir. 1988) (enumerating eight “[f]actors to be considered in determining whether a disclosure would require undue experimentation”). The Examiner did not consider any of the *Wands* factors. Rather, the Examiner concluded, without reasoning, that “any experimentation would be ‘undue experimentation’” because “the nature of the claimed invention is such that any experimentation could have potentially catastrophic worldwide consequences.” (emphasis in original). In doing so, the Examiner completely disregarded any method of experimentation other than performing the method, itself (e.g., using known methods of calculating, simulating, or otherwise predicting results). Such analysis is legally impermissible.

For the above reasons, the Examiner failed to make out a *prima facie* case of lack of enablement, and there is “no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.” *Bowen*, 492 F.2d at 863.

B. Obviousness

The Examiner rejected all pending claims as unpatentable over Chao in view of White and Brown. However, the Examiner failed to make a *prima facie* case of obviousness. Without a *prima facie* case of obviousness, any rejection under 35 U.S.C. § 103 is improper and should be overturned. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the Examiner must satisfy three basic criteria. First, the Examiner must demonstrate some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify a reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success. Finally, the Examiner must show that the cited prior art teaches or suggests all the claim limitations. *See* M.P.E.P. § 2143. Without conceding the second criteria, Appellant asserts that the rejection does not satisfy the first and third criteria.

The Examiner concedes that Chao fails to explicitly disclose many of the claimed steps in independent claim 11. White and Brown also fail to disclose the claimed steps. The Examiner failed to demonstrate any suggestion or motivation to modify Chao, White, or Brown to include the claimed steps. All three references identify the problem the present invention solves. As the Examiner characterizes them, White and Brown also emphasize the severity of the problem. However, neither White nor Brown provide a solution involving the claimed steps, and the Examiner does not point out any reference to the contrary. Rather, the Examiner only makes the

bare statement that "it is the examiner's position that the prior art suggests the claimed steps of selecting, calculating, determining, and positioning."

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

C. CONCLUSION

Because no *prima facie* case of obviousness has been made, Appellant respectfully submits that claims 11-20 are patentable under 35 U.S.C. § 112 and 35 U.S.C. § 103. Therefore, reversal of the rejection is courteously solicited.

VIII. CLAIMS APPENDIX

The text of the claims involved in the appeal are:

11. A method of modifying the axis of rotation of a planet comprising the steps of:
 - measuring the mass of a planet;
 - determining the center of mass of the planet;
 - characterizing the axis of rotation of the planet;
 - selecting a desired character of rotation;
 - calculating a moment of stability required to cause the desired character of rotation;
 - determining a position and a mass of a compensating substance sufficient to effect the moment of stability; and
 - positioning the mass in the position.
12. The method of claim 11 in which the position of the compensating substance is positioned an underground cavity.
13. The method of claim 11 in which the position of the compensating substance is positioned in an above ground cavity.
14. The method of claim 11 in which the substance is solid.
15. The method of claim 11 in which the substance is a liquid.
16. The method of claim 12 in which the substance is a liquid.
17. The method of claim 13 in which the substance is a liquid.

18. The method of claim 15 in which the liquid is water.
19. The method of claim 16 in which the liquid is water.
20. The method of claim 17 in which the liquid is water.

IX. EVIDENCE APPENDIX

Appellant has not submitted any evidence to the Examiner pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132. No other evidence has been entered by the Examiner and relied upon by Appellant in the appeal.

X. RELATED PROCEEDINGS APPENDIX

No decision has been rendered by any court or the Board in any related proceeding.

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ER264815627 US in an envelope addressed
to: MS Appeal Brief – Patents,
Commissioner for Patents, Alexandria, VA
22313-1450.
Date of Deposit: 4-11-05
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Respectfully submitted,

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